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10/809,007	03/25/2004	Steve M. Johnson	4022M	7771

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EXAMINER

ARK, DARREN W

ART UNIT PAPER NUMBER

3643

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/809,007

Applicant(s)

JOHNSON, STEVE M.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 4-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I - Figs. 1-4 and Species II - Figs. 5, 6.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with S. Michael Bender on Thursday, September 23, 2004 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12 and 13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wade 2,284,183.

Wade discloses an animated artificial bait comprising a simulated turtle body, shell portion, legs, tail, and head (although frog is depicted, turtles are within the scope of the invention; see col. 1, lines 4-8 where it is stated "The invention comprehends the animation of all artificial baits....including turtles..."), and also one or more hooks (6).

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bybee Des. 305,258.

Bybee discloses a simulated turtle fishing lure with at least one hook (see Fig. 1).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade 2,284,183 in view of McClenahan et al. Des. 320,639.

Wade does not disclose one or more hook reception eyes or a spoon portion. McClenahan et al. discloses one hook reception eye and a spoon portion (see Figs. 1, 2). It would have been obvious to a person of ordinary skill in the art to modify the lure of Wade such that it has one or more hook reception eyes and a spoon portion of McClenahan et al. in order to provide an attachment for the hook that allows the hook to move freely relative to the body for better fish hook ability and also to provide means for causing the lure to dive to greater depths.

8. Claims 2, 3, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade 2,284,183 in view of Wilkinson 5,546,694.

Wade discloses a simulated shell and bottom portions, but does one or more hook reception eyes, a spoon portion, or a scent emission chamber located between a shell portion and bottom portion. Wilkinson discloses a hook reception eye (for 14), a spoon portion (18), and a scent emission chamber (42) between a simulated shell portion (28) and bottom portion (38). It would have been obvious to a person of ordinary skill in the art to employ the hook reception eye, the spoon portion, and scent

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emission chamber of Wilkinson in the lure of Wade in order to provide an attachment for the hook that allows the hook to move freely relative to the body for better fish hook ability, means for causing the lure to dive to greater depths, and means to disperse scent from the lure so as to lure the fish based on sense of smell.

9. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade 2,284,183 in view of Wilkinson 5,546,694 as applied to claim 8 above, and further in view of Catarau 2,004,308 or Catarau 1,913,362.

Wade and Wilkinson do not disclose a chamber cover, a cover hinge, or a cover lock. Catarau '308 and '362 disclose a chamber cover (7 OR 3), a hinge (10 OR 4), and a lock (8 OR 5). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the chamber cover, hinge, and lock of Catarau '308 or '362 in the lure of Wade and Wilkinson in order to provide means for retaining bait in the chamber that allows scent to be emitted yet also allow the user to access the chamber interior so as to replenish or change bait therein.

10. Claims 2, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade 2,284,183 in view of Catarau 2,004,308 or Catarau 1,913,362.

Wade discloses a simulated shell and bottom portions, but does one or more hook reception eyes or a scent emission chamber located between a shell portion and bottom portion. Catarau '308 and '362 disclose a hook reception eye (see Figs. 1) and a scent emission chamber (6 OR 1) between a top portion and bottom portion. It would have been obvious to a person of ordinary skill in the art to employ the hook reception eye and scent emission chamber of Catarau '308 or '362 in the lure of Wade in order to

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provide an attachment for the hook that allows the hook to move freely relative to the body for better fish hook ability and means to disperse scent from the lure so as to lure the fish based on sense of smell.

11. Claims 2, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bybee Des. 305,258 in view of McClenahan et al. Des. 320,639.

Bybee does not disclose one or more hook reception eyes or a spoon portion. McClenahan et al. discloses one hook reception eye and a spoon portion (see Figs. 1, 2). It would have been obvious to a person of ordinary skill in the art to modify the lure of Bybee such that it has one or more hook reception eyes and a spoon portion of McClenahan et al. in order to provide an attachment for the hook that allows the hook to move freely relative to the body for better fish hook ability and also to provide means for causing the lure to dive to greater depths.

12. Claims 2, 3, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bybee Des. 305,258 in view of Wilkinson 5,546,694.

Bybee discloses a simulated shell and bottom portions, but does one or more hook reception eyes, a spoon portion, or a scent emission chamber located between a shell portion and bottom portion. Wilkinson discloses a hook reception eye (for 14), a spoon portion (18), and a scent emission chamber (42) between a simulated shell portion (28) and bottom portion (38). It would have been obvious to a person of ordinary skill in the art to employ the hook reception eye, the spoon portion, and scent emission chamber of Wilkinson in the lure of Bybee in order to provide an attachment for the hook that allows the hook to move freely relative to the body for better fish hook

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ability, means for causing the lure to dive to greater depths, and means to disperse scent from the lure so as to lure the fish based on sense of smell.

13. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bybee Des. 305,258 in view of Wilkinson 5,546,694 as applied to claim 8 above, and further in view of Catarau 2,004,308 or Catarau 1,913,362.

Bybee and Wilkinson do not disclose a chamber cover, a cover hinge, or a cover lock. Catarau '308 and '362 disclose a chamber cover (7 OR 3), a hinge (10 OR 4), and a lock (8 OR 5). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the chamber cover, hinge, and lock of Catarau '308 or '362 in the lure of Bybee and Wilkinson in order to provide means for retaining bait in the chamber that allows scent to be emitted yet also allow the user to access the chamber interior so as to replenish or change bait therein.

14. Claims 2, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bybee Des. 305,258 in view of Catarau 2,004,308 or Catarau 1,913,362.

Bybee discloses a simulated shell and bottom portions, but does one or more hook reception eyes or a scent emission chamber located between a shell portion and bottom portion. Catarau '308 and '362 disclose a hook reception eye (see Figs. 1) and a scent emission chamber (6 OR 1) between a top portion and bottom portion. It would have been obvious to a person of ordinary skill in the art to employ the hook reception eye and scent emission chamber of Catarau '308 or '362 in the lure of Bybee in order to provide an attachment for the hook that allows the hook to move freely relative to the



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body for better fish hook ability and means to disperse scent from the lure so as to lure the fish based on sense of smell.

***Allowable Subject Matter***

15. Claims 4-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA